

REMARKS

I. STATUS OF THE APPLICATION AND DISPOSITION OF THE CLAIMS

A. General Remarks

Claims 1, 3-40, and 42-58 are pending. Claims 4, 6-11, 21-39 and 48-58 are withdrawn from consideration by the Examiner. Thus, claims 1, 3, 5, 12-20, 40 and 42-47 are under consideration on the merits. No claims are amended herein.

B. Withdrawal of Prior Rejections

In the Present Office Action, the Examiner withdraws the rejection of claims 1, 3, 5, 16, 17, 40, 42, 45, and 46 under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 4,316,930 ("Stengle"); the rejection of claims 13, 18, and 47 under 35 U.S.C. §102(b) as being anticipated by, or, in the alternative, under 35 U.S.C. §103(a) as obvious over Stengle; the rejection of claims 1, 3, 5, 12-20, 40 and 42-47 under 35 U.S.C. §103(a) as being unpatentable over Japanese Patent Publication No. 1-249333 ("Nagamine") in view of Russian Patent Publication No. 2072121 ("Adolfovna") in view of Applicants' arguments in the response filed April 19, 2006; and the rejection of claims 1, 3, 5, 17, 40, 42, and 46 under 35 U.S.C. §103(a) as being unpatentable over Nagamine in view of Japanese Patent Publication No. 04-307787 ("Iketani") in view of Applicants' arguments in the response filed April 19, 2006. Office Action, pages 2, 4. Applicants thank the Examiner for the withdrawal of the aforementioned rejections.

C. Outstanding Claim Rejection and Indication of Allowable Subject Matter

In the Office Action, the Examiner rejects claims 1, 3, 13-20, 40 and 42-47 under 35 U.S.C. §103(a) as being unpatentable over Nagamine. *Id.* Further, the Examiner indicates that claims 5 and 12 are objected to as being dependant upon a

rejected base claim, but as allowable if rewritten in independent form. *Id.* at 4. While Applicants appreciate the Examiner's indication that claims 5 and 12 are allowable, Applicants maintain that all of the pending claims are allowable over the prior art of record for at least the reasons of record, as well as the reasons set forth below.

II. The finality of the present Office Action is premature

In the present Office Action, the Examiner indicates that claims 1, 3, 13-20, 40, and 42-47 are rejected under 35 U.S.C. §103(a) as being unpatentable over Nagamine, "for reasons of record." Office Action, page 2. Moreover, the Examiner indicates that the Office Action is final. *Id.* at 4. Applicants respectfully submit, however, that the finality of the present Office Action is premature for the reasons set forth below.

The Examiner is respectfully directed to M.P.E.P. 706.07(a), which states, *inter alia*,

Under present practice, second or any subsequent actions on the merits shall be final, **except** where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

M.P.E.P. 706.07(a) (emphasis added). In the present case, the §103(a) rejection of claims 1, 3, 13-20, 40 and 42-47 is a new ground of rejection that was not necessitated by an amendment or information disclosure included with Applicant's response filed April 19, 2006.

In support of this argument, Applicants note that aside from the present Office Action, the only time during the prosecution of this application that any claims were rejected under §103(a) in view of Nagamine alone was in the Office Action mailed

November 19, 2003 and the Office Action mailed June 3, 2004. In these earlier Office Actions, the Examiner rejected claims 1, 18 and 40 under 35 U.S.C. §103(a) in view of Nagamine. See Office Action mailed June 3, 2004, page 2 and Office Action mailed November 19, 2003, pages 2 and 3. In response to the Final Rejection mailed June 3, 2004, Applicants filed a Notice of Appeal on December 3, 2004 and a Request for Continued Examination ("RCE") on March 3, 2005. Together with this RCE, Applicants filed a claim amendment in which the limitations of claims 2 and 41 were inserted into claims 1 and 40 respectfully. See RCE and Amendment filed March 3, 2005, pages 2, 8, and 12. As a result, the Examiner withdrew the rejection of claims 1, 18, and 40 under 35 U.S.C. §103(a) in view of Nagamine in the Office Action mailed March 24, 2005. See Office Action mailed March 24, 2005, page 2 ("the rejection of claims 1, 18, 40 and 47 under 35 U.S.C. §103(a) as being unpatentable over [Nagamine] is moot in view of applicants' amendments"). Since the amendment filed March 3, 2005, Applicants have not further amended the claims.

Thus, present claims 1 and 40 (which are equivalent to prior claims 2 and 40) have never been rejected under 35 U.S.C. §103(a) in view of Nagamine alone. Accordingly, the rejection of these claims in the present Office Action, as well as the rejection of dependent claims 3, 13-20 and 42-47 is a new ground of rejection. As is clear from the above, this new ground of rejection was not necessitated by an amendment or information disclosure statement included with Applicants' response filed April 19, 2006.

For at least the foregoing reasons, Applicants submit that the Finality of the present Office Action contravenes the mandates of M.P.E.P. 706.07(a). Thus, the finality of the present Office Action is premature, and should be withdrawn.

III. The applied §103(a) rejection of claims 1, 3, 13-20, 40, and 42-47 is improper

Claims 1, 3, 13-20, 40, and 42-47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Nagamine. *Id.* Applicants respectfully disagree with and traverse this rejection for at least the following reasons.

To establish a prima facie case of obviousness, the Examiner must show that three basic criteria have been met. See M.P.E.P. § 2143. Specifically, the Examiner must establish: (1) that the prior art teaches or suggests all of the claim limitations; (2) that there is some teaching or suggestion in the prior art to make the modification; and (3) that one of ordinary skill in the art would have had a reasonable expectation of success in making the asserted modification. *Id.* As discussed in detail below, the Examiner fails to establish any of these three criteria in the Present Office Action.

The Examiner is respectfully directed to independent claims 1 and 40, which recite:

1. A reinforced laminate adapted for an electronic support, the laminate comprising: (a) a matrix material; and (b) at least one non-degreased fabric comprising at least one strand comprising a plurality of fibers, wherein at least a portion of the fabric has a resin compatible coating which is compatible with the matrix material in the reinforced laminate adapted for the electronic support, and the resin compatible coating comprises a plurality of particles.

40. An electronic support comprising (a) at least one non-degreased fabric comprising at least one strand comprising a plurality of fibers, wherein at least a portion of the fabric has a resin compatible coating which is compatible with a matrix material; and (b) at least one matrix

material on at least a portion of the at least one fabric; wherein the resin compatible coating comprises a plurality of particles.

Thus, claims 1 and 40 recite, *inter alia*: 1) a matrix material; and 2) a non-degreased fabric, wherein at least a portion of the fabric has a resin compatible coating that is compatible with the matrix material and comprises a plurality of particles.

In the Present Office Action, the Examiner asserts that

Nagamine teaches a laminate adapted for an electronic support...wherein the laminate comprises a glass cloth impregnated with a resin (page 1). In addition, Nagamine teaches that the glass cloth is formed from sized filaments that have been formed into yarns and subsequently woven into cloths wherein the glass cloth still has the sizing agent adhered thereto. Nagamine teaches that in cases where the sizing agent causes a problem in the adhesion with the resin, the glass cloth can be degreased. See page 3. Moreover, Nagamine teaches that the sizing agent used for the glass yarns include a recently developed non-desizing sizing agent that does not require degreasing or surface treatment and thereby eliminates degreasing and improving productivity and production yield. See page 10. Nagamine additionally teaches that a size composition comprising starch powder can be applied. See page 3. Hence, Nagamine teaches the inclusion of a plurality of particles.

Office Action, pages 2-3. The Examiner then concludes that

[w]hile the examples set forth in Nagamine utilize a glass cloth that has been degreased, the prior art reference is not limited solely to that which is taught in its' preferred embodiments...In the instant case, Nagamine would have provided direction to the skilled artisan to use as the fabric, a fabric that is sized with a sizing agent that does not require degreasing or more specifically, a non-degreased fabric, with the reasonable expectation of improving economic aspects of the production process and improving production yield.

Id. at pages 3-4. For at least the following reasons, Applicants respectfully disagree.

First, the Examiner has failed to establish that Nagamine teaches or suggests all of the elements of independent claims 1 and 40. Specifically, the Examiner has not established that Nagamine discloses a non-degreased fabric, wherein at least a portion

of the fabric has a resin compatible coating which is compatible with a matrix material, as recited in independent claims 1 and 40.

Indeed, although not expressly stated in the Present Office Action, the Examiner's argument appears to hinge on the implicit assertion that the "recently developed non-desizing agent" disclosed on page 10 of Nagamine is or can be the same as the size composition comprising starch powder recited on Page 3 of the reference. Proper consideration of the express teachings of Nagamine, however, would lead one of ordinary skill in the art to the opposite conclusion.

As noted above, the Examiner asserts that Nagamine discloses a size composition comprising starch particles. Office Action, page 2. While Applicants acknowledge the Examiner's position, the portion of Nagamine that supports this argument is devoted to a discussion of the prior art. See Nagamine, pages 2-3. Moreover, this same portion of the reference expressly states that

[t]he glass cloth which has just been woven still has the sizing agent and the like adhering thereto. In the case where such an agent causes a problem in the adhesion with the resin, the organic materials adhering to the glass cloth are removed by heating (this is referred to as degreasing)...Then, the glass cloth is impregnated with an epoxy resin or the like...

Id. at page 3. Nagamine, however, does not teach or suggest that the disclosed sizing composition comprising starch particles does not cause "a problem in the adhesion with the resin."

As further noted above, the Examiner asserts that Nagamine discloses "[a] recently developed non-desizing sizing agent, which does not require degreasing or surface treatment and thereby eliminates degreasing and improving productivity and

production yield.” Office Action, pages 2-3. Unlike the discussion regarding starch particles, the portion of Nagamine supporting this assertion is contained in a section of the reference devoted to a discussion of Nagamine’s invention. See Nagamine, page 10. Thus, Nagamine discloses that sizing compositions comprising starch particles were utilized in the prior art and exhibited various problems, some of which required degreasing of the fabric prior to impregnating the fabric with resin, whereas the invention of Nagamine may utilize a non-desizing sizing agent that eliminates the necessity of degreasing. *Id.* at pages 3, 10 (emphasis added).

Nothing of record however, teaches or suggests that the sizing agent of the prior art - which comprises starch particles - is equivalent to the Nagamine’s non-desizing sizing agent. Indeed, given that these sizing agents are disclosed in completely different portions of the reference, one of ordinary skill in the art would be led to the conclusion that the disclosed sizing composition comprising starch particles is not equivalent to the disclosed non-desizing sizing composition. This is particularly true, given that Nagamine: a) expressly states that the sizing compositions of the prior art (with which the disclosed sizing composition comprising starch particles are associated) may require degreasing to prevent problems with adhesion to an impregnating resin, whereas the non-desizing sizing composition “eliminates the necessity of degreasing;” and b) does not disclose that the non-desizing sizing agent may contain any particles whatsoever, much less the starch particles utilized in the disclosed prior art sizing agents. Nagamine, pages 3, 10.

Thus, the Examiner has not shown, and indeed cannot show, that Nagamine provides some teaching or suggestion that would motivate one of ordinary skill in the art

to modify the disclosure of the reference, e.g., by incorporating particles in the disclosed non-desizing sizing agent, in such a manner as to arrive at the claimed invention.

Again, the Examiner asserts that "Nagamine teaches the inclusion of a plurality of particles" into the non-desized sizing composition. As discussed above, however, Nagamine only discusses the use of sizing agents comprising particles as suitable for use in the prior art. Nagamine, page 3. Nagamine does not disclose, and certainly does not suggest, that the particles suitable for use in prior art sizing compositions are suitable for use in the disclosed non-desizing sizing agent. In fact, Nagamine expressly states that the non-desizing sizing agent "eliminates the necessity of degreasing," while at the same time disclosing that prior art sizing agents (of which the sizing agents comprising starch particles are a part) may require degreasing. Thus, one of ordinary skill, if anything, would have been led away from combining the particles of the disclosed prior art sizing formulations with the Nagamine's non-desizing sizing agent. Furthermore, Nagamine is completely silent with respect to the incorporation of particles into the disclosed non-desizing sizing agent.

For at the least the foregoing reasons, nothing in the prior art of record provides some teaching or suggestion to modify Nagamine in the manner suggested by the Examiner, much less with a reasonable expectation of success. Thus, the applied §103(a) rejection of claims 1, 3, 13-20, 40, and 42-47 is improper, and should be withdrawn.

III. CONCLUSION


In view of the foregoing remarks, Applicants submit that this claimed invention, as amended, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore request the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

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By: 
Mark D. Sweet
Reg. No. 41,469